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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,827	03/10/2004	Satoru Wakao	B588-042	7468

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EXAMINER

REZA, MOHAMMAD W

ART UNIT	PAPER NUMBER
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2136

MAIL DATE	DELIVERY MODE
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01/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,827

Applicant(s)

WAKAO ET AL.

Examiner

Mohammad W. Reza

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 14-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3 and 14-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/29/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the arguments filed on 11/29/2007.
2. Claims 1-3, and 14-28 are pending in the application.
3. Claims 1-3, and 14-19 have been rejected.
4. Claims 20-28 have been restricted.

Election/Restriction

Newly submitted claims 20-28 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

I. Claims 1-3, and 14-19, drawn to an apparatus for generating the only digital signature, classified in class 713, subclass 176.

II. Claims 20-28, drawn to a system wherein an image sensing apparatus generates the sensed image data incorporated with signature, classified in class 382, subclass 119.

The inventions are distinct, each from the other because of the following reasons:

5. Inventions I, and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such an image sensing apparatus generates the sensed image data. Subcombination I does not need such image sensing apparatus generates the sensed image data. Each

subcombination has specific limitations and utilities that are not found in the other inventions. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-28 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-3, and 14-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Examiner could not find any disclosure in the figure and spec of the present application, "a receiving unit that receives a first or second command, the first command including information indicating one of a plurality of secret keys; a secret key setting unit that sets a first secret key indicated by the first command as a second secret key, if the first command is received by the receiving unit; and a digital signature generating unit that generates the digital signature the digital data using the

second secret key, if a signature generating the second command is received receiving unit". There is no support in the written description that the first command indicates the first key. Instead, it mentions that the first command indicates to change the key (paragraph 0007). The other limitation that the digital signature generates by using the second key has no supports in the specification and figure as well. Instead, it supports that the digital signature generates by using any of the plurality of secret key not particularly second (changed) secret key (paragraph 0007). Examiner could not found any where in the specification and figure that it supports that a secret key setting unit that sets a first secret key indicated by the first command as a second secret key, if the first command is received by the receiving unit.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-3, and 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In these claims applicants mention "a receiving unit that receives a first or second command, the first command including information indicating one of a plurality of secret keys; a secret key setting unit that sets a first secret key indicated by the first command as a second secret key, if the first command is received by the receiving unit", which is generally narrative and indefinite with the invention. Applicants do not point out clearly which options include in the present invention by these limitations. So this limitation is indefinite with the present application. The examiner will interpret these limitations with

the regarding claims as best understood for applying the appropriate art for rejection purposes. Appropriate correction needs to overcome the rejection.

Response to Arguments

8. Applicant's arguments filed on 11/29/2007 have been fully considered but they are not persuasive.

Applicant argues that Hirata does not disclose the amended limitations, "a receiving unit that receives a first or second, the first or second command including information indicating one of a plurality of secret keys, a secret key setting unit that sets a first secret key indicated by the first command as a second secret key, if the first command is received by the receiving unit". Specifically, applicant argues that there is no mention in Hirata, of the key generation command received....including information indicating one of a plurality of secret keys. Examiner respectfully disagrees. Hirata actually teaches this limitation in his invention wherein IC card sends (first command) Secret key SK1 and Public key PK1 to key generation section in a card (paragraphs 0007), and thus it discloses that first secret key indicated by the first command. Applicant also argues that Hirata does not teaches that setting the first key as a second key secret key when the first key generation command received by the apparatus. In fact, Hirata discloses this limitation wherein the new key generation command received by the card then it changes to the new secret and public key SK2 and PK2 in place of SK1 and PK1 (paragraphs 0003, 0008) discloses this limitation. So, examiner found that the amended portion of the limitations are expressly discloses by Hirata.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-3, and 14-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Hirata et al hereafter Hirata (Foreign patent application JP2002300150).

10. As per claim 1, Hirata discloses a digital signature generating apparatus comprising: a receiving unit that receives a first or second command, the first command including information indicating one of a plurality of secret keys; a secret key setting unit that sets a first secret key indicated by the first command as a second secret key paragraphs, 0007, 0005), if the first command is received by the receiving unit; and a digital signature generating unit that generates the digital signature the digital data using the second secret key, if a signature generating the second command is received receiving unit (paragraphs 0003, and 0008).

11. As per claim 2, and 3 Hirata discloses a digital signature generating apparatus comprising: wherein said the digital signature generating apparatus is an IC card, and wherein said the digital signature generating apparatus is an apparatus including a multi-application operating system (paragraphs, 0005, 0007).

12. As per claim 14-16 Hirata discloses a digital signature generating apparatus comprising: a storage unit that stores the plurality of secret keys, wherein the digital data includes image data, wherein the receiving unit receives the digital data from an external device, the digital data being used to generate the digital signature of the digital data (paragraphs, 0005, 0003).

13. As per claim 17-19 Hirata discloses a digital signature generating apparatus comprising: wherein the digital signature generating unit generates a hash value of the digital data from the digital data in order to generate the digital signature of the digital data, wherein the digital signature generating unit encrypts the hash value of the digital data using the second secret key, in order to generate the digital signature of the digital data, wherein the receiving unit receives a hash value of the digital data from an external device, the hash value being used to generate the digital signature of the digital data (paragraphs, 0005, 0007).

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad w. Reza whose telephone number is 571-272-6590. The examiner can normally be reached on M-F (9:00-5:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **MOAZZAMI NASSER G** can be reached on **(571)272-4195**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mohammad Wasim Reza

AU 2136

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1/27/08